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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,392	11/12/2003	Kuniya Maruyama	MAKU 8814US	6840

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EXAMINER	
REESE, DAVID C	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/706,392	MARUYAMA, KUNIYA	
	Examiner	Art Unit	
	David C. Reese	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *4 and 5* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 6-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 November 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

[1] Claims 1-12 are pending.

Drawings

[2] Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

[3] The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. In the instant case, the examiner feels that the title "Shakudo Jewelry" is not a proper title for the instant application. "Shakudo Jewelry" as described by applicant, and the prior art, usually consists of between .5% and 5% 24k gold, the remainder being copper. In the instant case, however, the applicant has merely reversed the percentages of the above materials; so thus, due to the difference in material composition, the examiner does not feel that the instant invention can still be classified as such, "Shakudo Jewelry."

Claim Objections

[4] Claim 1 recites the limitation "the improvement" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the insertion" in the instant claim and dependent one therefrom. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the application" in the instant claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112

[5] Claims 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, the subject matter from the above claims is not found in the submitted (marked-up) specification.

Claim Rejections - 35 USC § 103

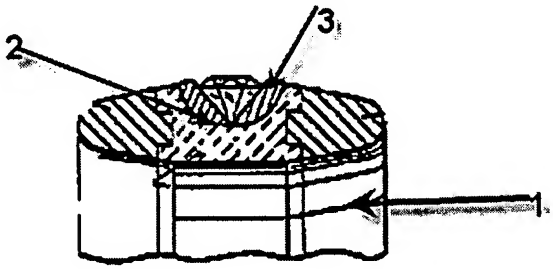
[6] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[7] Claims 1-3, and 6-8 are rejected under 35 U.S.C. 103(a) as clearly anticipated by West, US- 6,062,045, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, West teaches of an item of jewelry (see figure below) comprising a main body (1) having an inlay area of concaved shape (2), and a decorating part (3) secured in said inlay area (2), the improvement comprising said decorating part (3), said decorating part (3) being composed of precious metal components (col. 6, lines 28, and from Claim 1, "a precious metal disposed within said groove"), said decorating part (3) being secured in said inlay area (2) by a layer of solder (col. 6, line 30, "One way to affix precious metal to the part is to use a brazing process...") in said inlay area (2) between said decorative part (3) and said main body (1).



The difference between the claim and West is that West does not expressly state that the composition of the decorative part (3) secured in the inlay area (2) of the main body (1)

comprises 6 to 15% copper and 94 to 85% gold. First, and foremost, however, West with regard to the above issue states from part 5, beginning with line 61, of "a selected precious metal and/or other material installed in the groove 22...It will, of course, be appreciated that other forms of materials can be inlaid into the groove 22. For example, preformed metal, stone, ceramic, shell or other segments...Preferably, such items will be slightly recessed below the surfaces of the facets ..." Continuing, with part 6, line 32, "...that can be fabricated or forged into appropriate configurations and fit into the mating groove or channel 22. Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% can be applied on or around desired mating surfaces..." Continuing, with part 7, line 16 "...with the sculpted precious metal part 72 being mounted within a groove 74".

Thus, as shown above, West does indeed teach of a precious metal, preformed metal, as well as other materials and their ability via a brazing process to be configured into the inlay (2) area. And though West does not give explicit percentages of materials, the examiner would like to point out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin, 125 USPQ 416.* It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, and potential aesthetics (from applicant's disclosure on page 3, "...provides enjoyment"), etc, for the application, intended use, and design considerations of that material. Further, in addition, the examiner would also like to point out that such percentages as disclosed by applicant in the instant invention are merely the reverse of those percentages known in the art to comprise Shakudo Jewelry. Thus, it would also be readily understood and appreciated by those of

ordinary skill in the art, of the known aptitude to combine varying percentages of different metals for purposes of obtaining different color schemes, and utilizing the different physical properties of each metal individually as well as the result combined, such as corrosion and hardness characteristics of a jewelry item.

Re: Claim 2, wherein said jewelry has a curved surface at said inlay area (2).

Re: Claim 3, wherein said jewelry is selected from a group of jewelry including rings (Fig. 2), pendants, necklaces, earrings, cuff buttons, brooches, tie tacks, bangles, buckles, chokers, bracelets, watch band and glasses.

Re: Claim 6, wherein said main body (1) is made of a metal chosen from the group consisting of a gold alloy, a silver alloy, a platinum alloy, and combinations thereof (col. 3, paragraph [0027, "and gold or alloys thereof").

Re: Claim 7, wherein said jewelry includes a flux applied to said main body (1) and/or said decorating part (3) (from col. 3, in paragraph [0033], "Fluxed or flux free gold or silver soldered compounds varying in color and purity between 50% and 99% purity can be applied on or around desired mating surfaces of the hard material") prior to the insertion of said decorating part (3) in said inlay area (2) and solder (continuing from paragraph [0033], "One way to affix precious metal to the part is to use a brazing process" (to solder (two pieces of metal) together using a hard solder with a high melting point) placed about said decorating part (3) at a junction of said decorating part (3) and said main body (1); said layer of solder being [formed by applying heat to said item of jewelry; whereby, under heat, the flux evaporates forming a gap between said decorating item (3) and said main body (1) and said solder is pulled into said gap to form said layer of solder]

The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).* A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman, 489 F2d 742, 180 USPQ 324 (CCPA 1974).* Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug, 333 F.2d 905, 142 USPQ 161 (CCPA 1964).* In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al., 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).*

As for Claim 8, West teaches of an item of jewelry (see figure above) comprising a main body (1) having an inlay area (2) of concaved shape and a decorating part (3) secured in said inlay area (2); said inlay area (2) comprising a main channel (1/2) and at least one groove extending from a side of said channel (1/2); said decorating part (3) being composed of a copper alloy which contains 6 to 15 percent copper and 94 to 85 percent gold (see above statement from claim 1); said decorative part (3) being secured in said inlay area (2) said decorating part (3) corresponding in shape to the shape of the inlay area (2) main channel (1/2); said decorating part (3) being deformable to fill said at least one groove upon the application of pressure to said decorating part (3).

Conclusion

[8] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of jewelry item; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[9] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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DCR

3/8/06

ROBERT J. SANDY
PRIMARY EXAMINER